

**REMARKS**

Favorable reconsideration of this application is respectfully requested in view of the previous amendments and the following remarks.

At the outset, it is respectfully requested that the provisional double patenting rejection be held in abeyance until either this application or the copending application at issue is otherwise in condition for allowance.

With respect to JP 2000-514326 A, which was lined through in the Examiner initialed Form PTO-1449 included with the Official Action, Applicants respectfully submit that the submission of corresponding U.S. Patent No. 6,196,964 should have satisfied the requirement for a concise explanation of relevance. However, to expedite matters, attached to this response is the abstract of corresponding International Publication WO98/01184. It is respectfully requested that JP 2000-514326 A be officially made of record.

The claims are amended to address the issues raised in sections "5" and "7" of the Official Action. Withdrawal of the rejections under 35 U.S.C. § 112 is therefore respectfully requested.

Independent Claim 23 is rejected as being unpatentable over U.S. Patent No. 6,918,882, hereinafter Skujins, in view of U.S. Patent No. 5,372,144, hereinafter Mortier.

The Official Action correctly notes that Skujins does not disclose that the cross-sectional area of an end face of a first end portion of a second wire is less than the cross-sectional area of an end face of a first end portion of a first wire. The Official Action goes on to take the position that Mortier cures the above-noted deficiency in Skujins. Specifically, the Examiner states that Mortier discloses a guide

wire wherein the cross-sectional area of an end face of a first end portion of a second wire is less than the cross-sectional area of an end face of a first end portion of a first wire. This is not so.

The Examiner points to the interface between the segment 30 and the segment 34 in Mortier's Figs. 8, 10 and 11 in support of the above assertion. However, Mortier's specification makes no mention of the relative cross-sectional areas of those portions of the segments 30 and 34. Moreover, line 63 of column 5 through line 4 of column 6 of Mortier discloses that the segment 34 preferably has a substantially rectangular cross-section. It is clear from a careful study of Figs. 8, 10 and 11 that the broken parallel lines on segment 34 in those figures illustrate that a flat surface of the segment faces the viewer of the figures. Thus, the segment 34 illustrated in those figures has a non-circular cross section, likely a rectangular cross-section.

Moreover, those figures do not show the dimensions of the non-circular, likely rectangular cross-sectional-shaped segment 34 in the direction into the page. Accordingly, it is impossible to determine from the figures the relative cross-sectional areas of the portions of the segments 30 and 34 at issue here.

Finally, even assuming for the sake of discussion that the drawings appear to show the relative cross-sectional areas of the segments 30 and 34, that appearance alone of those proportions cannot be relied upon. "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue." See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000).

For the above reasons, neither Skujins nor Mortier, alone or in combination, disclose a method of making a guide wire wherein the cross-sectional area of an end face of a first end portion of a second wire is less than the cross-sectional area of an end face of a first end portion of a first wire, in combination with the other aspects of the method recited in Claim 23.

Claim 23 is therefore allowable over Skujins in view of Mortier, and withdrawal of the rejection of Claim 23 is respectfully requested.

New Claim 35 recites a method of making a guide wire wherein, *inter alia*, the cross-sectional area of the distal end portion in a vicinity of the welded portion of the second wire being less than the cross-sectional area of the end face of the proximal end portion at least after the welding. The attached drawing sheet illustrates an example of the specification's support for this aspect of the recited method. Neither Mortier nor Skujins disclose this aspect of the recited method. New Claim 35 is therefore also allowable.

The dependent claims are allowable at least by virtue of their dependence from allowable independent Claim 23. Thus, a detailed discussion of the additional distinguishing features recited in the dependent claims is not set forth at this time.

Early and favorable action with respect to this application is respectfully requested.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful

in resolving any remaining issues pertaining to this application the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

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New claim

FIG. 5

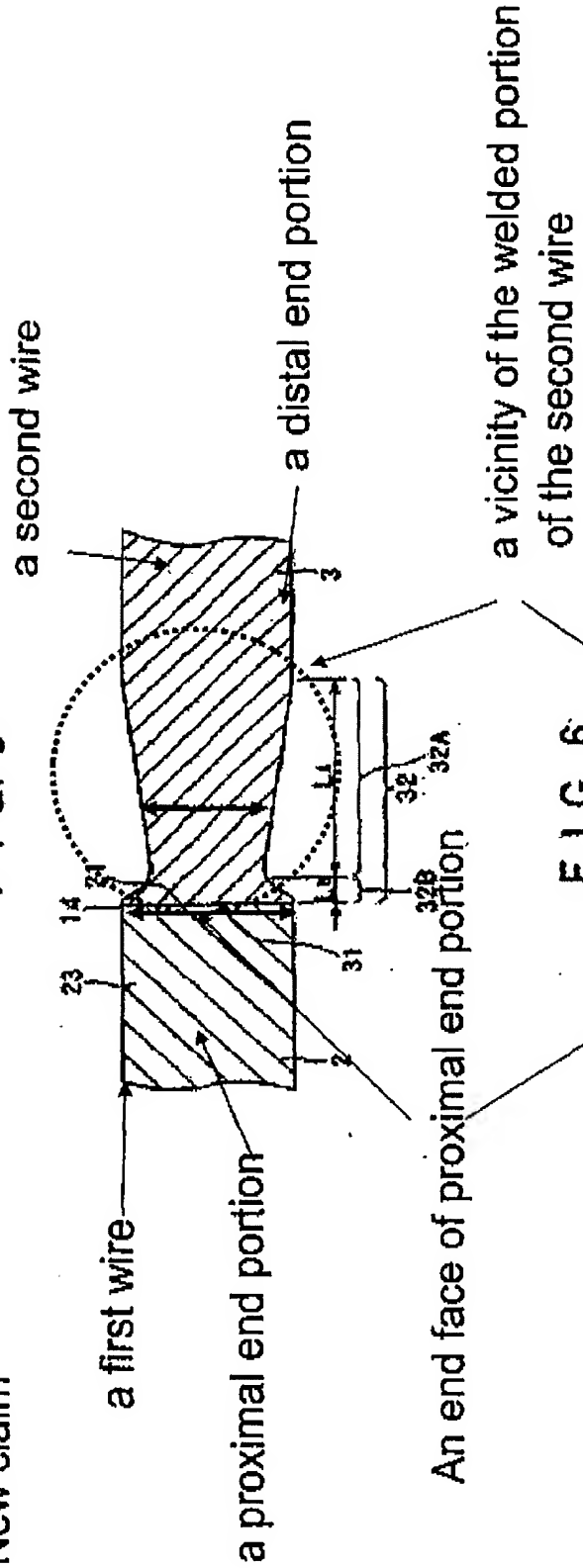
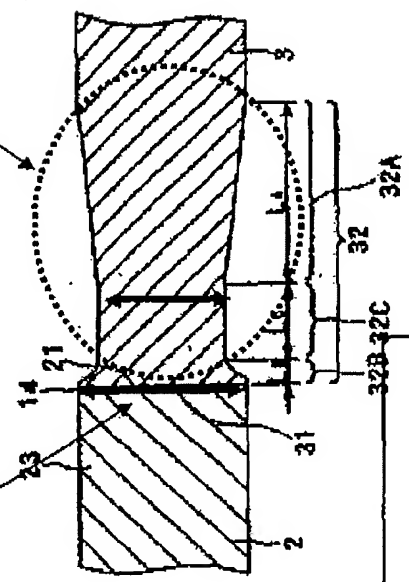


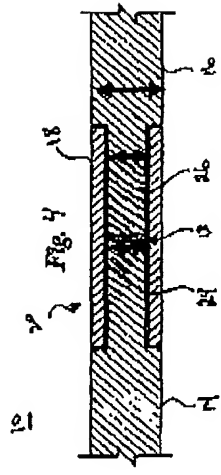
FIG. 6



New claim

Cross-sectional area of end face of proximal end portion > Cross-sectional area of distal end portion in vicinity of welded portion

Skujins et al:US6918882



Cross-sectional area of end face of proximal portion 14  $\leq$  Cross-sectional area of distal portion 16 in vicinity of welded portion

## COMBINATION OF A CAPSULE FOR BRACHYTHERAPY AND A GUIDEWIRE

**Publication number:** JP2000514326 (T)

**Publication date:** 2000-10-31

**Inventor(s):**

**Applicant(s):**

**Classification:**


- **International:** *A61M36/04; A61N5/10; A61M36/00; A61N5/10; (IPC1-7): A61N5/10; A61M36/00*


- **European:** A61N5/10B1


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**Also published as:**

 WO9801184 (A1)

 US6196964 (B1)

 NL1003528 (C2)

 EP0959950 (A1)

 EP0959950 (B1)

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Abstract not available for JP 2000514326 (T)

Abstract of corresponding document: **WO 9801184 (A1)**

A combination of a capsule for incorporating a radioactive source to be applied in brachytherapy and a guidewire, in which the capsule is attached to the guidewire via an adapter, and the adapter comprises a cable or thread with a flexibility greater than that of the guidewire.